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Action

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Guldenfels et al.

Serial No.: 09/909,447

Filed: July 19, 2001

For: Snap-On Side Guards

Examiner: Unknown

Group Art Unit: 3651

Commissioner for Patents
Washington, DC 20231

REPLY TO RESTRICTION REQUIREMENT

Sir:

An Office Action dated September 3, 2002 has been received in connection with the above-identified patent application. The examiner has restricted this application under 35 U.S.C. 121 to three groups of claims:

I Claims 1 - 7, drawn to a side guard;

II. Claims 8 - 16, drawn to a modular belt system; and

III. Claims 17 - 20, drawn to a method of forming a snap-on-guard.

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Applicants respectfully request removal of this restriction requirement for failure to establish a *prima facie* case.

Restriction of the invention in an application may be appropriate if a patent application claims two or more "independent and distinct" inventions (35 U.S.C. §121). According to the MPEP, the term "independent" is interpreted to mean that "there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect" (MPEP §802.01, emphasis added). The instant application is directed toward a side guard for use with a belt module (claims 1-7), a modular belt system having the same side guard (claims 8-16) and a method of forming a snap-on side guard for a radius belt by assembling the belt modules and side guard of the above modular belt system (claims 17-20). The relationship of the claims is set forth in part in the summary of the invention: "[a] plurality of snap-on side guards are mounted in vertical openings disposed in the belt modules" (Specification, p. 3, lines 8-9). Therefore, the claims are at least related as a snap-on side guard for belt modules, belt modules having snap-on side guards, and method for forming a radius belt having snap-on side guards. Because of this "disclosed relationship of the two or more subjects disclosed", the independent prong of the "independent and distinct" requirement under 35 U.S.C. §121 for restriction of claims is not met. Therefore, the office action fails to establish a *prima facie* case for restriction of this application. Accordingly, the restriction requirement should be withdrawn.

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The office action indicates that the Invention of Group III is classified in class 198, subclass 617. Applicants believe this classification to be in error.

The Classification Definitions (December 2000 Edition) sets forth that subclass 617 of class 198 is "indented under the class definition. Method, , of conveying a load or load portion from one place to another" (Classification Definitions, p. 198-63). Because claims 17-20 are directed toward a "method of forming a snap-on side guard for a radius belt", it is improper for claims 17-20 to be placed in class 198, subclass 617.

For at least the reasons given above, Applicants respectfully traverse this restriction requirement. Notwithstanding the Applicants traverse of the restriction requirement, for the purpose of providing a complete reply to the restriction requirement, applicants elect for prosecution the claims of Groups II and III. Should the patent office not agree with applicants suggested reclassification of the claims of Group III, applicants elect the claims of Group II for prosecution.

Respectfully submitted,



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